

REMARKS / ARGUMENTS

Claims 1-32 have been canceled, without prejudice or disclaimer, and new Claims 33-65 have been added; therefore, Claims 33-65 are pending. Applicants have carefully considered the application in view of the Examiner's action and, in light of the foregoing amendments and the following remarks, respectfully request reconsideration and full allowance of all pending claims.

Guidelines have been suggested for the arrangement of the specification. In response, Applicants have amended the specification to conform to the suggested guidelines.

Claim 4 has been objected to because of an informality. In response, Applicants have canceled Claim 4, without prejudice or disclaimer, rendering the rejection thereof moot.

Applicants have noted their obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time that a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f), or (g) prior art under 35 U.S.C. 103(a). However, after careful consideration of this obligation, Applicants' have concluded that there are no claims that were not commonly owned at the time a later invention was made and, therefore, that it is unnecessary to point out the inventor and invention date of any claim.

Claims 1-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,006,828 B1 to Czaja et al. (hereinafter “*Czaja*”) in view U.S. Patent Publication No. 2005/0148349 A1 to Putcha et al. (hereinafter “*Putcha*”). In response, Applicants have cancelled Claims 1-32, without prejudice or disclaimer, rendering the rejection thereof moot.

New Claims 33-65 have been added to more clearly recite, particularly point out, and distinctly claim distinguishing characteristics of the subject matter which Applicants regard as their invention. New claims 33-65 are based on original claims 1-32, and add no new matter to the application.

In response to *Czaja*, *Czaja* teaches an improved soft handoff procedure which reduces interference for a connected moving handset. In response to *Putcha*, *Putcha* teaches a more efficient configuration method wherein a check is made when a UE moves to a paging channel whether or not it has previously camped on that channel, and if it has, then it uses stored configuration data.

More specifically, *Czaja* is concerned with handoff processes in which UE is moving relative to base stations. There is no change in mode associated with a handoff; indeed the whole emphasis of handoff is to maintain the level of communication with as little change as possible, in spite of a new base station taking over the air interface for the moving UE. This is emphasized in the following passage at column 3, lines 8 to 11, of *Czaja*:

In order for communication transmissions to appear seamless to the user of the mobile station (a highly desirable goal), the communication link must be “handed off” to the next base station.

Cell selection is mentioned by *Czaja*, but only the selection of cells from a conventionally selected active set. These are then “gated off” during handoff to avoid interference. This can be seen for example in Claim 1, directed to a method of performing cell selection handoffs in a wireless communication system, the method comprising the steps of:

- a) determining a desired set of base stations, wherein the determining step comprises:
 - (i) obtaining a threshold parameter based upon receiver needs for proper reception, wherein the threshold is dependent upon a minimum of MS received power that is necessary to achieve a desired Quality of Service (QoS) for the MS,
 - (ii) determining relative base station signal strength for each base station in the active set, and
 - (iii) selecting a minimum number of relatively strong base stations from the active set required to provide the minimum of MS received power to the MS, wherein a combined signal strength of the selected strong base stations are compared with the threshold, and wherein additional strong base stations are selected from the active set until the combined signal strength exceeds the threshold;
- b) temporarily gating off all base stations except for the desired set of base stations determined during step a) for a selected time interval; and
- c) performing a soft handoff.

It is clear that *Czaja* fails to teach or suggest the manner of performing cell selection, including determining a candidate cell set, as presently claimed in each of currently pending independent Claims 33, 42, 51, and 59.

Putcha is, more specifically, concerned with reducing the time involved in configuring the UE after cell selection. The solution offered by *Putcha* is to use information already stored on the device rather than to spend time obtaining system information from the network, and it does this by configuring the UE for a paging channel of a cell previously camped on, whether or not the newly selected cell is the same one. *Putcha* fails to teach or suggest the presently claimed invention, wherein each independent claim goes to a next candidate set of cells whose use is triggered by a specific set of state changes in the UE. Rather, *Putcha* teaches what happens after cell selection. This can be seen from the content of the claims, for example, where all the independent claims are in the form:

*“A method....., the method comprising:
selecting a cell;
after selection, configuring the wireless communications device....”*

It is further noted that U.S. Patent No 6,917,807 to Vialen et al. (hereinafter “*Vialen*”), being cited in an Information Disclosure Statement, is concerned with methods of signaling between the network and the UE, rather than the apparatus in the UE. In the network context, *Vialen* teaches cell selection on transitioning out of dedicated channel mode (DCH) into common channel mode (CCH). The network provides a cell to the UE for use when the UE transitions from DCH to CCH.

Vialen is, however, limited to transitions from DCH, and fails to teach or suggest any type of transitioning to an idle mode.

Still further, *Vialen* fails to teach or suggest the UE as both identifying a candidate cell set, and selecting from a candidate cell set as claimed. Coupled with the fact that *Vialen* further fails to teach or disclose a selected cell set in combination with the state changes as presently claimed, Applicants respectfully submit that the presently pending claims are not anticipated by, or rendered obvious by, *Vialen*.

In view of the foregoing, it is apparent that none of the references, either singularly or in any combination, teach, suggest, or render obvious the unique combination now recited in independent Claims 33, 42, 51, and 59, namely, that of the UE establishing a candidate cell set,

the cells for UMTS-based networks, the UE selecting one cell from the candidate set, and further wherein the selected cell is used when transitioning to the idle state, or, from one of Cell_FACH, Cell_PCH, URA_PCH to one of Cell_FACH, Cell_PCH, URA_PCH. It is therefore respectfully submitted that Claims 33, 42, 51, and 59 clearly and precisely distinguish over the combinations of references in a patentable sense, and are therefore allowable over those references and the remaining references of record.

Claims 34-41, 43-50, 52-58, and 60-64 depend from and further limit independent Claims 33, 42, 51, and 59, in a patentable sense, and, for this reason and the reasons set forth above, are also deemed to be in condition for allowance.

By this amendment, Clams 1-32 have been deleted, without prejudice or disclaimer, and new Claims 33-65 have been added, resulting in a total of 33 claims, which constitute one additional claim over what was originally filed. Accordingly, please charge the amount of \$50.00 for the 37 C.F.R. § 1.16(i) fee for adding one additional claim to Deposit Account No. 50-2032 of Scheef & Stone, L.L.P.

Enclosed is a Petition for Extension of Time, along with authorization to charge the extension of time fees to Deposit Account No. 50-2032 of Scheef & Stone, L.L.P.

Applicants do not believe any other fees are due in connection with the filing of this paper, other than fees associated with the addition of one claim and the accompanying Petition for Extension of Time; however, in the event that any other fees are due, the Commissioner is hereby authorized to charge any required fees due (other than issue fees), and to credit any overpayment made, in connection with the filing of this paper, to Deposit Account No. 50-2032 of Scheef & Stone, L.L.P.

Applicants have now made an earnest attempt to place this application in condition for allowance. Therefore, Applicants respectfully request, for the reasons set forth herein and for other reasons clearly apparent, full allowance of Claims 33-65 so that the application may be passed to issue.

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AMDT. DATED JANUARY 7, 2008
REPLY TO OFFICE ACTION OF JULY 6, 2007

ATTY DKT NO. 1578.612 (PUS-1766)

Should the Examiner have any questions or desire clarification of any sort, or deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,

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